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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,072	03/12/2004	Martin John Glenton Hughes	GJE-70D1	9134

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EXAMINER

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,072	<b>Applicant(s)</b> HUGHES ET AL.	
	<b>Examiner</b> Padmavathi v. Baskar	<b>Art Unit</b> 1645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **RESTRICTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claims 1-2 and 7-8 drawn to a polypeptide and a vaccine, classified in class 530, subclass 350 .

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3).

Group II, claims 3-6 drawn to DNA, vector and host cell, classified in class 536, subclass 23.6

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3).

Group III, claims 18-19 drawn to an antibody , , classified in class 530, subclass 388.6.

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3).

Group IV, claims 9-10 drawn to a method for screening drugs using peptide classified in class 435, subclass 7.1

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3)

Group V, claims 11-12 drawn to a method for the detection of virulence using peptide, classified in class 435, subclass 4

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3).

Group VI, claims 13-17 drawn to a method for the treatment or prevention of a condition with bacterial streptococcal infection, classified in class 424 ,subclass 184.1

Further restriction to one SEQ.ID.NO or one "pho", a lab designated identifier required (see paragraph # 3).

2. The inventions are distinct, each from the other because of the following reasons:

Group I is directed to polypeptides, which are made of amino acids Groups II is directed to DNA, which consists of nucleic acids. Group III is drawn to an antibody and is distinct from Inventions I-II since it has an inherent affinity, avidity, and specificity that DNA or a simple protein is not capable of expressing. These products are different to each other structurally, biochemically and functionally and are drawn to patentably distinct molecules which have materially different physical and chemical properties and structures as represented by their divergent sequences.

Groups IV-VI are patentably different methods. For example: a method of treatment in Group VI requires infected animals, polypeptides and adjuvants etc where as Group IV, a method for screening drugs requires polypeptides, pharmaceutical drugs and ELISA plates etc. Thus these methods are different to each other using different biological reagents, different method steps which result in different outcome.

### **DISTINCT INVENTIONS**

3. For each group of inventions I-VI above, restriction to one of the following the polypeptides encoded by polynucleotides pho1-13, pho3-21, pho2-15, pho3-18, pho3-33, pho3-3 pho3-17, pho2-2, pho1-5, pho3-1, pho3-23, pho3-50, pho1-14, pho2-10, pho3-14, pho3-24, pho3-29 or polypeptides SEQ ID NO: 2, 4, 6, 8, 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33 and 35 is also required under 35 USC 121. Therefore, election is required of one of inventions I – VI and one of pho1-13, pho3-21, pho2-15, pho3-18, pho3-33, pho3-3 pho3-17, pho2-2, pho1-5, pho3-1, pho3-23, pho3-50, pho1-14, pho2-10, pho3-14, pho3-24, pho3-29 or one SEQ ID NO: 2, 4, 6, 8, 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33 and 35.

Inventions are pho1-13, pho3-21, pho2-15, pho3-18, pho3-33, pho3-3 pho3-17, pho2-2, pho1-5, pho3-1, pho3-23, pho3-50, pho1-14, pho2-10, pho3-14, pho3-24, pho3-29 and SEQ ID NO: 2, 4, 6, 8, 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33 and 35 are unrelated if it can be

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shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions; represent structurally different polypeptides, SEQ ID NO: 2, 4, 6, 8, 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35 or the polypeptides encoded by polynucleotides pho1-13, pho3-21, pho2-15, pho3-18, pho3-33, pho3-3 pho3-17, pho2-2, pho1-5, pho3-1, pho3-23, pho3-50, pho1-14, pho2-10, pho3-14, pho3-24, pho3-29. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects. Thus, each sequence is unique and patentably distinct since each sequence has a different structure with specific amino acid or nucleic acid and is identified by a specific lab identification number pho or SEQ.ID.NO. Restriction is deemed proper because these products appear to constitute patentably distinct inventions. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed pho or SEQ.ID.NO from any group elected.

4. Invention I is related to inventions IV, V and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Group I can be used in immunoaffinity chromatography methods for purifying antibodies and need not be used in the inventions IV, V and VI

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5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01

6. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

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7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Padma Baskar Ph.D.



SUSAN UNGAR, PH.D  
PRIMARY EXAMINER